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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,528	12/27/2001	Benjamin N. Eldridge	P6C3-US	2563
50905	7590	08/17/2006	EXAMINER	
N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			PATEL, PARESH H	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/034,528

Applicant(s)

ELDRIDGE ET AL.

Examiner

Paresh Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43,48,49,51-57,59-65 and 74-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43,48-49,51-57,59-65,74-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 06/06/2006 have been fully considered but they are not persuasive. Applicants have admitted that pending claims are drafted in product-by-process format, i.e. the claims are directed to a product -a "tested semiconductor device" (see page 11). In Exhibit 1 and Exhibit 2, Applicant's illustrates a structural differences in the resulting tested semiconductor device as compared to prior art semiconductor devices like Littlebury. Applicant relies on **the uniform scrub marks** made by the probe elements to illustrates a structural differences in the resulting tested semiconductor device as compared to prior art semiconductor devices. This is because, claims recites, "adjusting a planar orientation of probe elements of a probe card assembly to correspond to planar orientation of said electrical contact terminals".

Examiner disagrees because the claim is directed to the product i.e. "tested semiconductor device", it is noted that the features upon which applicant relies (i.e., the uniform scrub marks as further argued) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Since, Littlebury reference discloses the claimed product and in product-by-process claims, the claims are directed to the product and not the process, arguments about Littlebury reference are not true.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 43, 48-49, 51-57, 59-65, 74-101 are rejected under 35 U.S.C. 102(b) as being anticipated by Littlebury (US 5012187).

Littlebury anticipated (fig. 2) a tested semiconductor device (12 tested in wafer form, see lines 26-29 of column 2 and lines 40-63 of column 4) produced by providing a wafer (lines 11-16 of column 4, preferred embodiment being wafer form) having a plurality of semiconductor devices thereon, each of the semiconductor devices including a plurality of electrical contact terminals (13) as recited in claims 43 and 82.

Regarding claim 48, dicing the wafer to singulate the semiconductor devices is anticipated by Littlebury (lines 11-18 of col. 4).

Littlebury anticipated the limitations of claims 49, 51-57, 59-65 and 74-81 and 83-101, because the additional limitations presented in each claims 49, 51-57, 59-65, 74-81 and 83-101 relies from the process of producing the product and does not further limit the scope of Applicants' claimed invention that is directed solely to "a tested semiconductor device."

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4. Claims 43 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Aldaz et al. (US 2002/0057098 A1).

Regarding claims 43 and 82, Aldaz et al. (hereafter Aldaz) discloses tested semiconductor device produced by a process comprising providing the wafer (300) having a plurality of semiconductor devices thereon, each of said semiconductor devices including a plurality of electrical contact terminals [320].

5. Claims 43 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Khoury et al. (US 6441629).

Regarding claims 43 and 82, Khoury et al. discloses tested semiconductor device produced by a process comprising providing the wafer (300) having a plurality of semiconductor devices thereon, each of said semiconductor devices including a plurality of electrical contact terminals [320].

6. Claims 43 and 82 are rejected under 35 U.S.C. 102(e) as being anticipated by Parrish (US 6215320).

Regarding claims 43 and 82, Parrish discloses tested semiconductor device produced by a process comprising providing the wafer (26) having a plurality of semiconductor devices thereon, each of said semiconductor devices including a plurality of electrical contact terminals (terminals of DUT's of 26).

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 43, 48-49, 51-57, 59-65, 74-101 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27 and 35 of U.S. Patent No. US 5,974,662. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the instant application, which are directed to the product-by-process and claims of US Pat. 5,974,662 discloses substantially similar subject matter to produce tested semiconductor devices.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 571-272-1968. The examiner can normally be reached on 8:00 to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Paresh Patel 08/14/06  
Primary Examiner  
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August 14, 2006